

REMARKS

Claims 5-9, 11-24, 34, and 36-41 are all the claims pending in the application.

Claim 5 has been allowed; claims 6-9, 11 and 16-20 are rejected; claims 12-15, 21-24, 34 and 36-41 are withdrawn from consideration.

Claims 6 and 16 have been converted to product-by-process format, as suggested by the Examiner in the Advisory Action dated February 12, 2004. The process steps of claims 6 and 16 are those recited in claim 34.

No new matter has been added. Entry of the amendments is respectfully requested.

I. Rejection of Claims under 35 U.S.C. §112

In the Advisory Action dated February 12, 2004, the Examiner states that the rejections under 35 U.S.C. §112, for lack of written description and enablement (set forth in paragraph 4 of the Office Action dated August 12, 2003), are being maintained.

The Examiner states that the claims must include identifying characteristics for use in search and examination of the claimed subject matter. In the alternative, the Examiner indicates that the claims should be amended to recite the claimed subject matter as a product-by-process.

Applicants include herewith amendments to the two rejected independent claims under consideration, placing them in product-by-process format.

In view of the amendment of the claims based on the Examiner's suggestion, the claims are fully enabled and have adequate written description support in the specification as filed. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

II. Request for Rejoinder

A. Applicants note that claims 12-15 and 21-24 recite methods of making an ansamitocin using the *Actinosynnema* strains recited in claims 6-9, 11 and 16-20. As stated in MPEP §821.04, in applications where product and process claims drawn to independent and distinct inventions are subject to restriction, and Applicants elect claims to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined. As further stated, the process may be a process for making or using the product.

Claims 6-9, 11 and 16-20 recite novel *Actinosynnema* strains. As claims 12-15 and 21-24 recite methods of making ansamitocins using the enhanced *Actinosynnema* strains, these claims recite a process of using the product of claims 6-9, 11 and 16-20.

Thus, rejoinder of method claims 12-15 and 21-24 is proper and warranted. Applicants thereby request rejoinder of method claims 12-15 and 21-24 withdrawn from consideration by the Examiner.

B. Applicants also respectfully request rejoinder of method claims 34 and 36-41. As the method recited in claims 34 and 36-41 is the same as the method used to produce the *Actinosynnema* strains recited in claims 6-9, 11 and 16-20, no further search would be required to review these method claims, and no additional burden would be placed on the Examiner.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the


AMENDMENT UNDER 37 C.F.R. §1.114(c)
U.S. Appln. No. 10/057,561

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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